PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Leonard R. Speiser et al.   Examiner: Gerald J. O'Connor

Serial No. 10/666,681   Group Art Unit: 3627

Filed: September 18, 2003   Docket: 2043.093US1

Title: PRODUCT RECOMMENDATION IN A NETWORK-BASED COMMERCE
SYSTEM

APPEAL BRIEF UNDER 37 CFR § 41.37

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The Appeal Brief is presented in response to the Notice of Panel Decision from Pre-
Appeal Brief Review mailed on August 16, 2006 and further in support of the Notice of Appeal
to the Board of Patent Appeals and Interferences, filed on July 18, 2006, from the Final
Rejection of claims 15-22 of the above-identified application, as set forth in the Final Office
Action mailed on April 18, 2006.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit
Account No. 19-0743 in the amount of $500.00 which represents the requisite fee set forth in 37
C.F.R. § 41.20(b)(2). The Appellants respectfully request consideration and reversal of the
Examiner's rejections of pending claims.

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1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, EBAY INC.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants that will have a bearing on the Board's decision in an appeal of this matter.

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3. STATUS OF THE CLAIMS

Claims 15-22 are currently pending in this patent application. A Final Office Action was mailed on April 18, 2006. Claims 15-22 stand finally rejected, and their rejection is the subject of the appeal of this matter.

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4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the Final Office Action dated April 18, 2006.

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5. SUMMARY OF CLAIMED SUBJECT MATTER

Independent method claim 15 relates to providing listing recommendations to users of a network-based commerce system (*see, e.g.,* Application at ¶ 7). In an embodiment, a plurality of listings is arranged in a plurality of divisions (*see, e.g.,* Application at ¶¶ 23, 27). The method identifies a division based on user interaction (*see, e.g.,* Application at ¶ 27), identifies at least one frequently used search term associated with the identified division (*see, e.g.,* Application at ¶ 27), and provides a link to the user to listings associated with the search term (*see, e.g.,* Application at ¶ 27).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1)   Was a *prima facie* case of anticipation under 35 U.S.C. § 102(a) properly made with respect to claims 15-22 using Spiegel et al. (hereinafter Spiegel) (U.S. Patent No. 6,466,918)?

7. ARGUMENT

A)   The Applicable Law

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

B)   The References

Spiegel: discloses a system for identifying popular nodes within a browse tree or other hierarchical browse structure based on actions of users (*see* Spiegel at Abstract).

C.   Discussion of the Rejections

C.1   The Rejection of claims 15-22 using Spiegel.

Appellants respectfully submit that a *prima facie* case of anticipation of claims 15-22 has not been established because Spiegel fails to disclose all elements of the present claims.

In particular, Appellants cannot find in the cited portions of Spiegel any disclosure of "identifying at least one frequently used search term associated with the identified division; and providing a link to the user to listings associated with the at least one frequently used search term" as presently recited in independent claim 15.

Instead, Spiegel apparently describes identifying a popular node (e.g., a category or product) in a "browse tree," where the node's popularity may be based on various criteria. *See* Spiegel at col. 6, lines 5-29. For example, criteria used to indicate a category node's popularity include "the number of purchases made within each category, the number of searches performed within each category, [and] click-through counts." *See* Spiegel at col. 6, lines 21-26. However, Spiegel apparently does not describe using frequently used *search terms* to identify popular nodes. While Spiegel does discuss the use of a "number of searches performed within [a]

category" as an example of a criterion that may be used to indicate popularity, Appellants respectfully argue that the number of searches performed within a category node merely indicates the use of a category or traffic within a category. The number of searches performed is distinctly different from the frequency of search terms used in a query. Thus, it appears that frequently used search terms are simply not identified. In fact, the phrase "search term" does not appear in the Spiegel reference. Independent claim 15 does not simply recite identifying a frequently used search term, but a frequently used search term that is associated with the identified division, a category being an example of such a division. Spiegel apparently does not describe identifying frequently used search terms, either independent from or associated with, an identified division.

The Final Office Action attempts to provide an example of a frequently used search term by referencing "Olympics" as shown in FIG. 1A. *See* Final Office Action at ¶ 6. However, in the example shown, "Olympics" is apparently a title of a category as it is illustrated under a "Featured Categories" header—hence, the depiction of "Olympics" in this example is not an illustration of a search term as the Final Office Action asserts. *See* Spiegel at FIG. 1A; col. 7, line 12. Presumably, the "Olympics category" was promoted to its featured status based on a popularity score, as discussed above and as described in Spiegel at col. 7, lines 6-67. As previously discussed, the popularity score may be a function of several factors, however, none of the factors described or disclosed in Spiegel include identifying frequently used search terms.

Moreover, Appellants respectfully argue that the Final Office Action's assertion that Spiegel discloses "providing a link to the user to listings associated with the at least one frequently used search term" must also fail. While Appellants concede that hyperlinks are disclosed in Spiegel, and in fact the category "Olympics" may appear as a hyperlink in some embodiments, Appellants do not concede that such a hyperlink references a listing associated with at least one frequently used search term, as required by claim 15. In fact, as frequently used search terms are not disclosed or described in Spiegel, it defies logic to conclude otherwise.

Regarding dependent claims 16-22, these claims depend from claim 15, either directly or indirectly, and are therefore believed to be patentable for at least the foregoing reasons. Thus, Appellants respectfully request withdrawal of the basis of rejection of these claims.

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8. SUMMARY

In sum, because the cited portions of Spiegel apparently do not disclose all elements recited or incorporated in claims 15-22, Appellants respectfully submit that there is no *prima facie* case of anticipation of these claims. Therefore, Appellants respectfully request reversal of all bases of rejection of all claims.
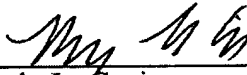
Respectfully submitted,

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By their Representatives,

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Date __10/18/06__ By _____

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this _18_ day of October 2006.

___Peter Rebuffoni___   _____
Name   Signature

CLAIMS APPENDIX

15.   A method of providing listing recommendations to users of a network-based commerce system including a plurality of listings arranged in a plurality of divisions, the method including:

identifying a division of the plurality of divisions based on user interaction with the network-based commerce system;

identifying at least one frequently used search term associated with the identified division; and

providing a link to the user to listings associated with the at least one frequently used search term.

16.   The method of claim 15, including communicating a web page to the user including a hyperlink to the listings associated with the at least one frequently used search term.

17.   The method of claim 15, wherein the listings associated with each frequently used search term are listings that would be located if the user conducted a search of the network-based commerce system using the at least one frequently used search term.

18.   The method of claim 15, wherein the at least one frequently used search term is ranked in one of an ascending and descending order according to a number of occurrences of listings in a division associated with the at least one frequently used search term.

19.   The method of claim 18, including periodically adding new listings and removing terminated listings prior to determining the number of listings in each division associated with each frequently used search term so that the ranking is dependent upon supply and demand for the listings.

20.   The method of claim 15, including searching the network-based commerce system using at least one frequently used search term when the user selects the link.

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21.   The method of claim 15, wherein the at least one frequently used search term is displayed according to rank in one of an ascending and descending order.

22.   The method of claim 15, wherein one or more frequently used search terms are assigned to each of the plurality of divisions, the divisions being defined by categories.

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EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.

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